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-- REMARKS --

Applicants thank the Examiner and his supervisor for the many courtesies extended in the interview of November 23, 2004. Applicants regret that the Examiner refused an after final interview, especially given the confusion regarding Applicant's statements in the first interview. The Examiner's Interview Summary, and final rejection, does not accurately reflect Applicants' counsel's statements during the interview. Applicant never agreed to amend claims 1, 11, and 21. Instead, Applicant agreed to present new claims addressing the indicated limitations, and the Examiner's attention is directed to claims 24-25 that were previously presented.

A. Claims 1-25 were rejected under 35 U.S.C. §103(a) as unpatentable over Nunnelly in view of Craig

The §103(a) rejection of claims 1-25 is traversed. In order to maintain this §103(a) rejection, each and every claimed element must be taught or suggested by the references, alone or in combination, in at least as great detail as claimed. Independent claims 1, 11, 21, 24, and 25 each require providing a first tier of at least one disk, the first tier storing at least one popular unit and providing a second tier of at least one disk, the second tier storing at least one unpopular unit.

The Examiner correctly recognizes the failure of Nunnelly to teach providing a first tier of at least one disk, the first tier storing at least one popular unit and providing a *second tier of at least one disk*, the second tier storing at least one unpopular unit. However, Craig does not teach the claimed elements, and is nonanalogous art.

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Nunnelly does not teach the claimed elements

Contrary to the Examiner's assertion, Nunnelly does not teach "determining whether a request for a unit requires processing on the first tier or second tier" as claimed in claims 1, 11, 21, 24, and 25. The Examiner cites to column 2, lines 39-42, but this citation is misplaced. Nunnelly teaches only that a storage manager, known as an allocation manager, chooses the clusters upon which incoming data is written, rather than determining whether a request for a unit requires processing on the first tier or second tier.

Craig does not teach the claimed elements

Craig teaches a media server for supplying video and multi-media data over the public switched telephone network. The Craig system is online storage units 278, 282, and 286. Further included is Archival Magnetic Tape 290. Craig also refers to identification 290 as "archival storage 290". See, e.g. column 9, lines 30-41 and column 10, lines 31-34. Since Craig teaches use of *archival magnetic tape*, Craig does not teach providing a second tier of at least one *disk*. Those of ordinary skill in the art readily recognize the differences between tape and disk memory.

Yet further, neither Craig nor Nunnelly teach or suggest "powering on a second tier disk to copy the requested unit from the second tier disk to a first tier disk, if the requested unit is stored on the second tier" as claimed in claims 1, 11, 21, 24, and 25. As claimed, the requested unit is copied from the second tier disk to a first tier disk if the requested unit is stored on the second tier. The Examiner's citation to column 3 lines 48-52 is entirely misplaced, as that selection only teaches that data may be buffered at a central office, but not that the requested unit is copied to a first tier disk.

Craig is nonanalogous art

In order to rely on a reference under 35 U.S.C. §103, the reference must be analogous art. The reference must either be in the field of applicants' endeavor or if not,

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then be reasonably pertinent to the particular problem with which the inventor was concerned. See, MPEP §2141.01(a), *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

The Examiner argues that Craig's teaching of a RAID system *for error removal or fault tolerance* renders Crag analogous art. (See, pages 4-5 of the 2/3/2005 Office Action) However, the Examiner's own statement shows the fallacy of his position. In order to be analogous, the reference must be *reasonably pertinent to the particular problem with which the inventor was involved*. See, page 5 of the February 3, 2005 office action, as well as *In re Wood*, 202 USPQ 171. However, *the problem confronted by the instant inventor is not* a problem of error removal or fault tolerance, it is a *power management by disk allocation* problem.

Craig is not concerned with the field of Applicants' endeavor, and it is therefore not analogous art and cannot support the §103(a) rejections. Applicants' endeavor is directed at operating RAID (Redundant Arrays of Inexpensive Disks) systems, and not to media servers for supplying data over the public switched telephone network. There is no grounds to suggest that one concerned with operating RAID systems would consult literature relating to media servers for supplying data over the public switched telephone network. First, use of a RAID system is generally unrelated to use of the public switched telephone network. Those of ordinary skill in the art readily recognize that RAID (Redundant Arrays of Inexpensive Disks) do not pass information using phone lines. Second, RAID systems generally are able to access disks simultaneously (see page 1, lines 22-24), which is a feature not available in tape systems such as the system taught in Craig. At most, one of ordinary skill in the art of serving media files over a public telephone network could be motivated to seek a RAID system for error removal or fault tolerance based on Craig's teachings, but the person of ordinary skill in the art in the art of operating RAID servers would not be motivated to consult a reference relating to serving media files over the public telephone network.

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In *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992), the court found that the reference and invention were not part of the same endeavor where the reference taught a different structure for a different purpose under different conditions. In this case, the structure is different, the purpose is different and there are different conditions. First, the claim requires a second tier of at least one *disk* rather than a tape, so the structure is different. Second, the purpose of providing a second tier of at least one *disk* is different than archiving to *tape* for media servers for supplying data over the public switched telephone network. Third, different conditions exist, as Applicants field of endeavor is related to operating RAID systems rather than media servers for supplying data over the public switched telephone network.

In *Wang Laboratories, Inc. v Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993), the court found that a SIMM case was not related to compact modular memories, even though both SIMMS and compact modular memories relate to "memory." In this matter, as in Wang, the claims are intended for RAID systems, whereas the reference system was developed for use in unrelated systems, and only teaches use of tape drives.

The Examiner has not addressed the "different structure for a different purpose" argument.

Furthermore, the Examiner provides no evidence of the level of skill of one of ordinary skill in the art to support a finding of obviousness or that one of such skill would consult these references. Without establishing the level of skill, there can be no objectivity in the determination of obviousness. *See, e.g.*, MPEP §2141.03. "The importance of resolving the level of skill of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991). Furthermore, there is no indication reflected in the prior art itself of the level of ordinary skill in the art.

Therefore, Craig cannot be considered analogous art, and the §103(a) rejection premised in part on Craig is flawed.

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Claims 2-10 and 12-20 each depend directly or indirectly from claims 1 or 11 respectively. Therefore, claims 2, 3, 6, 7, 9, 10, 12, 13, 16, 17 and 19-23 are patentable over the references for at least the same reasons.

Additionally, claims 22 and 23 each require "generating space on the first tier disk" which is not taught or suggested by Craig, contrary to the Examiner's assertion. At most, Craig teaches a determination of whether the disk or tape is capable of storing the entirety of the program in a single memory device. However, Craig never teaches that in the event that the disk/tape is not capable of storing the entirety, additional space is to be generated on the first tier disk.

Withdrawal of the rejections to claims 1-25 is requested.

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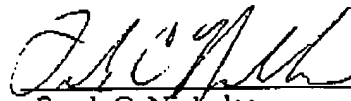
CONCLUSION

The Applicant respectfully submits that claims 1-25 as listed herein fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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